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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/737,314 | 12/16/2003 | Yogesh B. Gianchandani | UOM 0283 PUSP | 5950 |
| 4743 7590 11/21/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606 | | | EXAMINER YABUT, DIANE D | |
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| | | | 11/21/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/737,314

Applicant(s)

GIANCHANDANI ET AL.

Examiner

Diane Yabut

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This action is in response to applicant's amendment received on 9/12/07.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

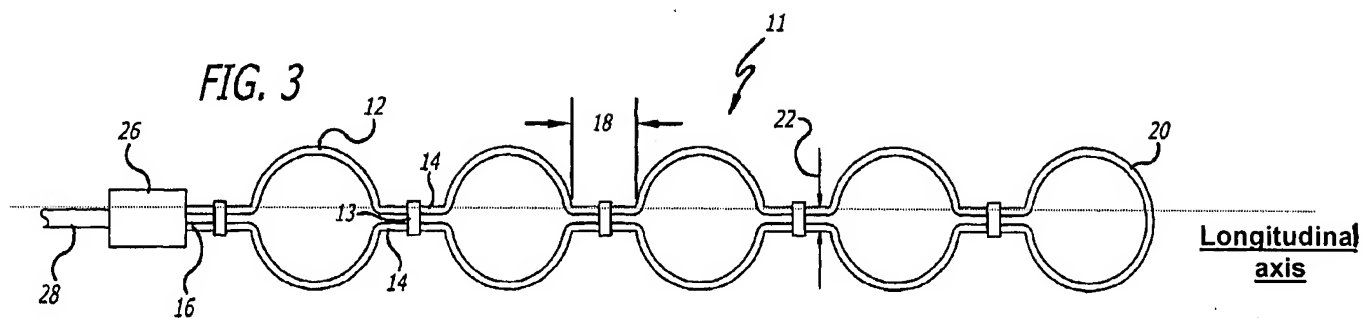
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-6, 8-16, 21, and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by **Leopold** (U.S. Pub. No. **20020173839**).

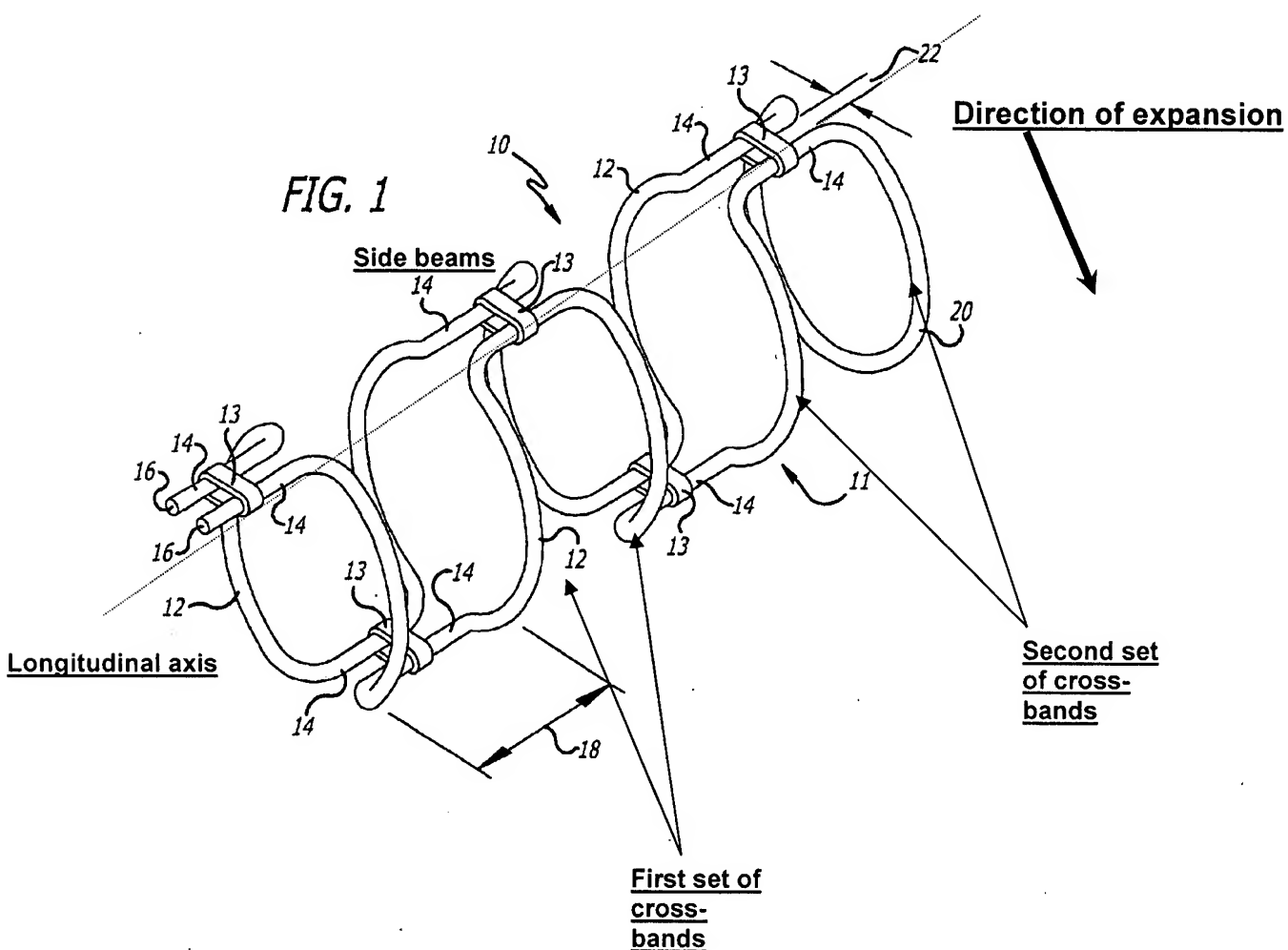
Claim 1: Leopold discloses a planar structure **11** comprising first and second spaced side beams **14** which extend along a longitudinal axis, and a plurality of spaced cross-bands **12** which connect the side beams together wherein a first set of the cross-bands are expandable in a first direction substantially perpendicular to the longitudinal axis to form a 3-D structure **10** (Figures 1 and 3, page 5, paragraph 67).

Claim 2: Leopold discloses a second set of the cross bands **12** being expandable in a second direction substantially opposite the first direction to form a mesh-like 3-D structure (Figures 1, 3, and 10).

Claim 3: Leopold discloses adjacent cross-bands are expandable in the opposite directions to form a mesh-like 3-D structure (Figures 1, 3, and 10).



UNEXPANDED, "FLAT" OR "PLANAR"



CROSS-BANDS (12) EXPANDED IN A DIRECTION SUBSTANTIALLY
PERPENDICULAR TO LONGITUDINAL AXIS

Claims 4-6: Leopold discloses the planar structure plastically deforming during expansion so that the 3-D structure is free standing and has a cylindrical geometry or is a tubular stent (page 1, paragraph 12, page 5, paragraph 67).

Claims 8-10: Leopold discloses the cross-bands including a series of folded beams having an involute pattern or a switchback pattern (Figures 1-3 and 10).

Claim 11: Leopold discloses each of the cross-bands **12** including hinges **20**, **13** for interconnecting adjacent folded beams (Figures 1, 3, and 10).

Claims 12-16: Leopold discloses the side beams and cross-bands including biocompatible surface coatings and made of biocompatible material or a shape-memory alloy wherein the planar structure is expandable and the side beams and cross-bands are formed by removing material from a sheet of metal (pages 3-4, paragraph 49, page 6, paragraph 72)

Claim 21: Leopold discloses the 3-D structure **10** being a helical coil, or having rings or loops (Figure 1).

Claim 23: Leopold discloses the helical coil includes first and second spaced rings at opposite ends thereof and wherein each of the rings is formed by an adjacent pair of expanded cross-bands **12** (Figure 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Leopold** (U.S. Pub. No. **20020173839**), as applied to Claims 1 and 16 above, and further in view of **Smith** (U.S. Pub. No. **20020156525**).

Claims 7 and 17: Leopold discloses the claimed device except for the planar structure including a conductive foil and the sheet material including conductive foil, and wherein side beams and cross-bands are formed by electric discharge machining the conductive foil.

Smith teaches a conductive foil and the sheet material including conductive foil, and wherein side beams and cross-bands are effectively formed by electric discharge machining the conductive foil (page 3, paragraph 33). It would have been obvious to one of ordinary skill in the art at the time of invention to provide conductive foil and forming the cross-bands by electric discharge machining, as taught by Smith, in order to form the stent "faster and with higher quality."

5. Claims 18-20, 22-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Leopold** (U.S. Pub. No. **20020173839**), as applied to Claim 1 above, and further in view of **Pacetti** (U.S. Pub. No. **20020188345**).

Claims 18-20, 22-23, and 25: Leopold discloses the claimed invention including the helical coil including first and second spaced rings at opposite ends thereof and wherein each of the rings is formed by an adjacent pair of expanded crossbands, except for at least the first side beam including a link portion being thinned or being made of a fragile material relative to the other portions of the

first side beam having a mechanical strength lower than other portions of the first side beam to allow the first side beam to break at the link portion during expansion of the first set of cross-bands, the structure comprising at least one electrical inductor.

Pacetti teaches at least a first side beam including a link portion being thinned or being made of a fragile material relative to the other portions of the first side beam having a mechanical strength lower than other portions of the first side beam to allow the first side beam to break at the link portion during expansion of the first set of cross-bands, the structure comprising at least one electrical inductor (page 2, paragraph 23 and page 4, paragraph 36). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a weak link portion, as taught by Pacetti, to Leopold, in order to make the stent easier to image with MRI.

6. Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Leopold** (U.S. Pub. No. **20020173839**), as applied to Claims 1 and 23 above, and further in view of **Da Silva** (U.S. Patent No. **6,729,336**).

Claims 24 and 26: Leopold discloses the claimed invention including a first ring and side beams and cross-bands, except for the elements including a dielectric part which mechanically connects but electrically insulates adjacent portions of the structure.

Da Silva teaches a stent including a dielectric part which mechanically connects but electrically insulates adjacent portions of the structure in order to

enhance a signal (col. 7, lines 7-24). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a dielectric part which also insulates, as taught by Da Silva, to Leopold in order to better enhance a signal.

Response to Arguments

7. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DY

A handwritten signature in black ink, appearing to read "M. Hayes", with a stylized, cursive script.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER